

Remarks

1. Summary of Office Action

In the office action dated September 12, 2003, the Examiner rejected claims 1-4 and 6-11 under 35 U.S.C. § 102(e) as being anticipated by Harvey *et al.*, U.S. Patent No. 6,487,583 ("Harvey"). Additionally, the Examiner rejected claims 5 and 12-16 under 35 U.S.C. § 103(a) as being obvious over a combination of Harvey and Lim *et al.*, U.S. Patent No. 6,574,599 ("Lim").

2. The Claimed Invention

As shown above, Applicant has cancelled claims 1-3, 9-11, 13-14, and 16. Now pending are claims 4-8, 12, and 15, of which claims 4, 12, and 15 are independent. The present invention, as recited in various ways in each of Applicant's claims, is directed to a method and system whereby a Personal Address Book (PAB) may be used to provide or to access various other services or tools for users of a network. Each of the claims, in one way or another, includes the elements of selecting certain PAB entries corresponding to certain associated users, inviting these associated users to a subscribing community, receiving the associated users' responses to these invitations, and ultimately generating a plurality of new PABs, wherein each new PAB is created in response to each acceptance or positive response of an associated user.

3. Response to § 102 Rejections

The Examiner rejected claims 1-4 and 6-11 under 35 U.S.C. § 102(e) as being anticipated by Harvey. Applicant has cancelled claims 1-3 and 9-11 and therefore respectfully traverses this rejection as moot with respect to claims 1-3 and 9-11. Further, Applicant respectfully traverses this rejection with respect to claims 4 and 6-8, because Harvey fails to teach all of the elements of any of these claims as required by M.P.E.P. § 2131 to establish an anticipation rejection.

By way of example, Harvey fails to disclose the element of generating a plurality of new PABs, wherein each new PAB is created in response to each associated user's acceptance of that associated user's invitation. At best, the element of Harvey that is functionally most similar to such a PAB is a "communication address book." (Harvey, col. 4, lines 44-61.) However, while Harvey discloses that a user can *access* a pre-existing communication address book (*see, e.g., id.*), at no point does Harvey disclose *creating* a new communications address book in *response* to an invitee's acceptance of an invitation to join a subscribing community.

Applicant respectfully disagrees with the Examiner's implication that Harvey's "mailing list" is the equivalent of Harvey's "address book." (September 12, 2003, Office Action, p. 4, lines 8-9.) Harvey makes clear that mailing lists are lists of subscribed members of a particular community, not members' individual address books. Harvey specifically explains that "a user may subscribe and/or unsubscribe to a given list" (Harvey, col. 18, lines 45-60, at lines 59-60), or that a user may "sign[] on to a mailing list" (Harvey, col. 22, line 7). If at all related to anything of the present invention, Harvey's "mailing list" is at best functionally most analogous to a "subscribing community," not a PAB. (See, *e.g.*, Harvey, col. 7, lines 44-45.) Thus, although a user of Harvey's invention can accept an invitation to join a gaming community, that gaming community will not subsequently generate a Personal Address Book for the new user. In contrast, the claimed invention actually responds to a user's acceptance of an invitation to join a subscribing community by generating a Personal Address Book for the accepting user.

Harvey nowhere discloses creating a PAB for each of the users who accepts an invitation, i.e., "in response to receiving each of said acceptances" as recited in claim 4, nor does Harvey even disclose the creation of any PAB or communications address book at all. The portions of Harvey that the Examiner pointed to in this regard merely teach the process of inviting users to

join a community (such as a gaming community for instance). The Harvey system sends an invitation to a designated user, providing the user with (i) an executable component that, when invoked by the user, downloads a community application to the user's station and (ii) an acceptance component that, when invoked by the user, allows the user to accept the invitation and join the community. These portions do not stand for the proposition of creating a PAB for each user who accepts an invitation, as recited in claim 4, nor do they even stand for the proposition of creating a PAB for the creator of the community.

For example, Harvey, col. 13, lines 6-26, is merely a description of the function of "inviting other users to participate in and/or join a community," by which a user's communication address book is merely retrieved or otherwise accessed. Similarly, Harvey, col. 14, line 65 to col. 15, line 23, merely broadly describes an "executable component" which may assist the invitee in "obtaining the proper information and/or files to access and interact with a community." However, nowhere does Harvey include in any description of such information or files any teaching of responding to an invitee's acceptance of an invitation to join a subscribing community by creating a new communications address book. As a result, Harvey does not teach all of the limitations of claim 4. Thus Harvey does not anticipate claim 4 nor any of claims 5-8, all of which are dependent upon claim 4.

4. Response to § 103 Rejections

The Examiner rejected claims 5 and 12-16 under 35 U.S.C. § 103(a) as being obvious over a combination of Harvey and Lim. Applicant respectfully traverses this rejection as moot with respect to cancelled claims 13-14 and 16. Further, Applicant respectfully traverses this rejection with respect to claims 5, 12, and 15, because the combination of Harvey and Lim does not disclose or suggest the combination of elements in any of claims 5, 12, or 15. Under

M.P.E.P. § 2143, in order to establish a *prima facie* case of obviousness of a claimed invention by applying a combination of references, the proposed combination must teach or suggest all of the elements of the claimed invention, which the combination of Harvey and Lim fails to do. Therefore, a *prima facie* case of obviousness does not exist for any of claims 5, 12, or 15.

a. Claim 5

Claim 5 ultimately depends from claim 4. Because Harvey fails to disclose or suggest all of the limitations of claim 4, for the reasons discussed above, Harvey necessarily also fails to disclose or suggest all of the limitations of dependent claim 5. Furthermore, neither Lim nor the combination of Harvey and Lim fails to make up for the deficiency of Harvey. Lim is merely directed to voice-recognition-based methods, none of which involve the creation of a PAB in response to receiving acceptances from associated users who have been invited to subscribe to a subscribing community. Applicant further submits that the art provides no suggestion to extend Lim in this way. The only basis for extending Lim in this way is Applicant's claims, i.e., Applicant's invention; yet it would be impermissible to use Applicant's claims as a blueprint for hindsight reconstruction. Consequently, the combination of Harvey and Lim fails to teach or suggest all of the elements of claim 5, and Applicant respectfully submits that a *prima facie* case of obviousness of claim 5 does not exist.

b. Claims 12 and 15

Both claim 12 and claim 15 refer to "creating a plurality of second Personal Address Books in response to receiving said answer from said invited callers." Applicant respectfully submits that the combination of Harvey and Lim fails to teach or suggest at least this function of the pending claims. Specifically, no portion of Harvey, including each portion cited by the Examiner, either teaches or suggests this element of claims 12 and 15. For instance, Harvey, col.

7, lines 24-48, merely allows the creator to set up a mailing list, which at best is analogous to a subscribing community (such as a gaming community); Harvey, col. 13, lines 6-26, is merely a description of the inviting function; and Harvey, col. 14., line 65 through col. 15, line 23, merely describes an "executable component" with certain applications. At no point in these passages or elsewhere in Harvey is there a teaching or suggestion relating to the function of creating a PAB in response to receiving positive responses from invited callers. Furthermore, for the reasons stated above, neither Lim nor the combination of Harvey and Lim fails to make up for the deficiency of Harvey with respect to the teaching of this function. Consequently, the combination of Harvey and Lim fails to teach or suggest all of the elements of either claim 12 or claim 15. A *prima facie* case of obviousness therefore does not exist for either claim 12 or claim 15.

5. Conclusion

For the reasons set forth above, Applicant submits that claims 4-8, 12, and 15 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF**

Dated: December 10, 2003

By: Jennifer M. Means
Jennifer M. Means
Reg. No. 53,311